

RESPONSE AND REQUEST FOR RECONSIDERATION

In response to the Office Action of October 6, 2008 Applicants hereby request the Examiner to reconsider the claims in view of the present amendments and remarks.

The Amendments

Applicants have amended independent claims 1, 21 and 36 to specify the technical features of claim 24.

The amendment is supported by the specification (see page 5, lines 17 to 21), and also original claim 9.

In view of the amendment described above, claim 24 has now been cancelled.

Claim 35 has also been cancelled.

Claims 25 to 29 have been amended by making them dependent on claim 1.

Claim 21 has also been amended by inserting the word group into the following text “(ii) ammonia or an organic nitrogen-containing base reacted with the acidic group”. This amendment ensures consistency of claim language.

It is submitted that the amendments described above are fully supported by the application and do not add subject-matter.

Remarks

The Examiner has not raised a 35 U.S.C. 102 rejection. Accordingly, it is submitted that the present invention is deemed novel.

The Examiner has raised a 35 U.S.C. 103(a) rejection to claims 1-5, 21, 23, 24, 31-37 over Moreton et al. (WO 02072529, that is equivalent to US 6,596,038). The following reasoned statements apply to independent claims 1, 21 and 36.

The Examiner contends that Moreton discloses a reaction product of a hydrocarbyl substituted aromatic compound containing carboxylic and hydroxyl groups (calixarenes) and ammonia or amine which are organic compounds. Reference to ammonia and the amine which are organic compounds is disclosed within the context of the subject-matter of column 5, lines 64 to 60.

The Examiner is respectfully requested to refer to the enclosed common general knowledge as described in Kirk-Othmer, Concise Encyclopedia of Chemical Technology, page 24, sub-heading Catalysis. The definition of a catalyst is defined as:

“A Catalyst is a substance that alters the velocity of a chemical reaction without appearing in the products.”

“Catalysts are believed to function through an unstable chemical complex formed between catalyst and reactant molecules.”

The text described above indicates that a catalyst does not permanently react with other reactants in a particular system. Accordingly, the catalyst is not present as a group or moiety of the final product.

In view of the fact that a catalyst does not appear in the final product, this common general knowledge is applied to the disclosure of Moreton in column 5, lines 54 to 60. Described therein are base catalysts (see line 54). The base catalysts include alkali or alkaline earth metal hydroxides, ammonia or a hindered amine (see line 56). Thus Moreton discloses linear compounds as possibly being prepared with a catalyst such as ammonia or a hindered amine. Since the person skilled in the art knows from common general knowledge that catalysts do not appear in the final product, starting from Moreton the present invention is not derived. The reason is because the product of Moreton does not form a final reaction product containing an amine. In contrast, the present invention does specify a reaction product with an amine.

In addition to the above, the Applicant submits that the Moreton reference is not an enabling disclosure with respect to deriving a product that forms a final product from the reaction of an amine with an aromatic compound having an acidic group. As such it may not be used by a skilled person attempting to derive reaction products of amines and a hydrocarbyl substituted aromatic compound containing an acidic group as presently claimed. Accordingly, the Examiner is respectfully requested to withdraw Moreton as a reference.

In the event that the Examiner is not persuaded that Moreton should be withdrawn as an enabling reference, it is submitted that independent claims 1, 21 and 36 are unobvious over Moreton in view of the technical reasoned statements described above. Since a skilled person would not arrive at the subject matter of independent claims 1, 21 and 36 from starting from Moreton all dependent claims are unobvious over Moreton. The Examiner is respectfully requested to withdraw the rejection under U.S.C. 103(a) and find all claims allowable over Moreton.

If the Examiner is persuaded that Moreton et al. (WO 02072529, that is equivalent to US 6,596,038) is not enabling and is therefore withdrawn, the rejection under U.S.C. 35 103(a) further in view of Hoke (US 4,090,971) is obviated.

If the Examiner maintains Moreton as a reference the following reasoned statements are submitted in order to highlight unobviousness of claims 25-30 of the present invention in view of Moreton and Hoke.

The Examiner is requested to withdraw all 35 U.S.C. 103(a) rejections and find all claims unobvious over the cited prior art.

If a skilled person were to combine Moreton and Hoke, the compound that would result would be expected to have surfactant, antioxidant or dispersant properties. In particular Moreton discloses in column 2, line 65 to 67 that the inventive linear compounds are useful as surfactants and/or antioxidants. Hoke discloses in column 10, lines 38 to 42 that the additives described therein are useful in lubricants where they function primarily as dispersants; that is, they maintain accumulated sludge, dirt and other insolubles in suspension.

In contrast, the reaction product of the present invention is described as in addition to dispersant performance they also provide antiwear performance. Antiwear performance of the reaction product of the present invention is demonstrated by the data provided in Table 1 of the application. In contrast, the antiwear performance is not taught or suggested by either of Moreton nor Hoke. Accordingly, any resultant combination by a skilled person of the subject-matter of Moreton and Hoke would have the expectation that product would be useful as a dispersant, a surfactant, an antioxidant or some combination thereof. Performance as an antiwear agent would not have been expected. The present invention does have antiwear performance.

In view of the reasoned statements above, the Examiner is respectfully requested to withdraw the 35 U.S.C. 103(a) rejections to claims 25 to 30 in view of Moreton and Hoke.

Any additional required fees, or any insufficiency or overpayment of fees, should be charged or credited to deposit account 12-2275 (The Lubrizol Corporation).

Respectfully submitted,

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